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09/535,314	03/24/2000	Gary Bridger	391442003700	2416

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 01/02/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/535,314

Applicant(s)  
Bridger et al.

Examiner  
Venkataraman Balasubramanian

Art Unit  
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 19, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7, 12, 13, 51, 55-58, 98, and 102 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 12, 13, 51, 55-58, 98, and 102 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 & 6 20) ☐ Other:

### **DETAILED ACTION**

Applicants' response to restriction requirement filed on 10/19/2001 is made of record. Election of Group IX drawn to claims 1-4, 6-7,12-13, 51, 55-58, 98 and 102 along with species 8907 of example 61 in paper # 12 is acknowledged. Claims 1-4, 6-7, 12-13, 51, 55-58, 98 and 102 will be examined to the extent the embrace the elected subject matter. Since applicants' have not traversed the restriction requirement, the restriction is deemed as proper and is maintained.

Claims 1-4, 6-7,12-13, 51, 55-58, 98 and 102 are now pending.

### ***Specification***

The abstract of the disclosure is objected to because the abstract is more than one page long. A short precise abstract within 150 words is needed. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6-7,12-13, 51, 55-58, 98 and 102 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Following reasons

clear what is the difference between these two choices. An appropriate correction is needed.

2. Also in claim 1, the recitation of the phrase "optionally substituted sulfonyl" is indefinite as it is not clear what would be an "unsubstituted sulfonyl". An appropriate correction is needed.
3. Again in claim 1, the recitation of "C<sub>0-6</sub> alkyl" is indefinite as it is not clear what is a "C<sub>0</sub>" alkyl is. Note the same in C<sub>0-6</sub> alkylamino and also in claim 51. An appropriate correction is needed.
4. Claims 7 and 55 recite the phrase "optionally substituted hydroxyl" which is indefinite as it is not clear what these substituents are. Reading page 14 of specification, it appears that alkanoyl, carbonyl etc are to be considered as "optionally substituted hydroxyl" which contradicts the definition shown on page 13 wherein the hydrogen of hydroxyl appears to be replaced with various groups. A correction or clarification is needed.
5. Claim 98 recites choice of compounds form a list wherein the first choice is code name for a compound, which is followed by a species. It is not clear what is the first recited choice. An appropriate correction is needed.
6. Claim 102 is an improper composition claim, as a composition requires more than one ingredient. A correction is needed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 7 and 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowles et al. US 5,563,151.

Bowles et al. teaches several amino acid derivatives which include generically compounds claimed herein in the instant claims, as PAF-receptor antagonists. See formula I on col. 1 and note the definition of W, Z, Q, R1, R2, R3, and B. on col. 1-3. Note when W is an imidazopyridine, Z is choice b where U is hetero or aryl ring, Q a bond and B is a choice c i.e. B is Y, the compounds taught by Bowles generically includes those claimed in the instant claims. See col. 3-18 for various preferred embodiments and method of making. See examples 1-149 on col. 19 through 41 for various compounds made.

The reference differs from the instant claims in not exemplifying compounds wherein Q is a bond not a CO or SO<sub>2</sub> as seen in examples 1-149.

However, Bowles et al. equivalency of the compounds made wherein Q is CO or SO<sub>2</sub> with those compounds wherein Q is a bond in the definition of W, Z, Q, R1, R2, R3, and B. as noted in col. 1-3. Furthermore, Bowles et al. has clearly contemplated making compounds wherein Q is a bond as evidenced by the suggestion of base for the reaction on col. 13, line 20.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compound of formula I with W, Z, Q, R1, R2, R3, and B. including Q as a bond, U as hetero ring or aryl and Y as heterocyclic ring

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as permitted by the reference and expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above

***Information Disclosure Statement***


References cited in Information Disclosure Statement (paper # 5 & 6) have been considered and made of record. Prior art search using CAS ONLINE was incomplete as even with the said restriction the number of compounds exceeded the limit set forth. Hence examiner has relied on EAST search with positively recited bicyclo ring systems for X variable and the references provided in the IDS for this action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on weekdays from 8.30 AM to 5.00 PM. The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

VB  
V. Balasubramanian

12/27/2001

  
RICHARD L. RAYMOND  
PRIMARY EXAMINER  
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